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*AMS*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/164,777 10/01/98 MULLOR

M REINC4237.01

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TM11/1018

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EXAMINER

SPENCER AND FRANK  
SUITE 300 EAST  
1100 NEW YORK AVENUE NW  
WASHINGTON DC 20005-3955

TRAMMELL, J

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 10/18/00

*3*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/164,777	Applicant(s) MULLOR ET AL.	
	Examiner Calvin L Hewitt II	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 1998.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:  
         1. ☐ received.  
         2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_  
         3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____                                    |

*Status of Claims*

1. Claims 1-15 have been examined.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-4 and 11-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ginter et al U.S. Patent No. 5,892,900.

As per claim 1, Ginter et al teach of a system and method for secure transactions management and electronic rights protection that:

- restricts software operation within a license limitation (column 5, lines 29-41 and column 6, lines 29-65)
- utilizes a computer that has a first non-volatile memory area (column 70, lines 40-65)

, a second non-volatile memory area (column 70, lines 40-65) and a volatile memory area (column 71, lines 12-25)

- provides a means of selecting a program residing in the volatile memory (column 71, lines 25-27 and column 82, lines 12-52)
- sets up a verification structure in the non-volatile memories (column 70, lines 23-53 and column/line 63/67-64/15)
- verifies the program using the structure (column 70, lines 23-53 and column/line 63/67-64/15)
- and acts on the program according to the verification (column 70, lines 23-53 and column/line 63/67-64/15).

As per claim 2, the method and system of Ginter et al provide for a license authorization bureau in the form of a VDE (virtual distribution environment) distributor and/or administrator (column/line 278/40 to 281/44).

As per claim 3, the method and system of Ginter et al discloses a verification method with a license authorization bureau that comprises of:

- a two-way data communication link between said bureau and end-user computer (figure 77)

- a method for establishing end-user rights (column/line 278/40 to 281/44)
- data encryption using keys (column 281, lines 10-22)
- creating a license record from the selected program at the bureau (column 71, lines 25-27, column 82, lines 12-52, column/line 278/40 to 281/44 and column 15, lines 10-34).

As per claim 4, the method and system of Ginter et al also provides a means of encrypting the license record for the selected program from the second volatile memory (column/line 65/55 to 66/47).

As per claim 6, the method and system of Ginter et al provides a means for establishing a licensed software program. Where said program contains license record data and is found in the volatile memory (column 71, lines 25-27, column 82, lines 12-52, column/line 278/40 to 281/44, column 15, lines 10-34, figure 8 and column 96, lines 37-41).

As per claim 10, the method and system of Ginter et al provide a means for restricting a program's operation with predetermined limitations if the authorization is invalid (column 279, lines 21-32).

As per claim 11, the method and system of Ginter et al provide for a ROM BIOS (figure 69G and column 70, lines 39-53).

As per claim 12, the method and system of Ginter et al provide for an EEPROM BIOS (figure 69G and column, lines 54-65).

As per claim 13, the method and system of Ginter et al provide for RAM (column 71, lines 16-25).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al U.S. Patent No. 5,892,900 as applied to claim 3 above, and further in view of Goldman et al 5,684,951. As per claim 3, Ginter et al disclose a verification structure. In addition, Ginter et al disclose a system and method for secure transaction management and electronic rights protection utilizing encryption keys (column 206, lines 57-65).

However, Ginter et al do not disclose pseudo unique keys. Goldman et al teach of a method and system for user authorization over a multi-user computer system. In said system, a user has valid id but lacks an authorized means of access. Using pseudo unique keys (abstract, lines 19-21), said user can validate said means of access. Therefore, it would have been obvious to a person of ordinary skill in the art of encryption, to incorporate pseudo unique keys into the system of Ginter et al.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al U.S. Patent. 5,892,900 in view of Goldman et al U.S Patent 5,684,951. Ginter et al teach of a method and system for electronic rights protection comprising of volatile memory, non-volatile memory, license records location and licensed software programs (see section 2 rejections pertaining to claims 1, 3, 4 and 6). Ginter et al also use encryption keys (column 206, lines 57-65).

However, Ginter et al do not make use of pseudo unique keys in their system. Goldman et al teach of a method and system for user authorization over a multi-user computer system through the use of pseudo unique keys (abstract, lines 19-21). Therefore, it would have been obvious to a person of ordinary skill in the art of the time the invention was made to utilize pseudo unique keys in the system of Ginter et al.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al U.S. Patent No. 5,892,900 as applied to claim 6 above, and further in view of Goldman et al U.S Patent 5,684,951. Ginter et al disclose a method for authoring content that includes encryption keys (column/line 282/ 33 to 283/34). As per claim 6, Ginter et al disclose a method for selecting a licensed software program from the volatile memory to form a license record. However, Ginter et al do not use pseudo unique keys for purposes of encryption. Goldman et al teach of a method and system for user authorization over a



multi-user computer system through the use of pseudo unique keys (abstract, lines 19-21). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use pseudo unique keys.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al U.S. Patent No. 5,892,900 in view of Goldman et al U.S Patent 5,684,951 and Richardson, III U.S. Patent No. 5,490,216. Ginter et al teach of a system and method for encrypting and decrypting of licensing related communications between end-user(s) and a license authorization bureau (column/line 282/33 to 283/34 and 168/25 to 169/40). Ginter et al also teach of volatile and non-volatile memory areas used in conjunction with licensed software programs (columns 70-72, column 82, lines 12-52, column/line 278/40 to 281/44, column 15, lines 10-34, figure 8 and column 96, lines 37-41). However, Ginter et al do not disclose pseudo unique keys. Goldman et al provide for the use of pseudo

unique keys (abstract, 21-23). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made, to incorporate pseudo unique keys into the system of Ginter et al.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Richardson , III teaches a system for software protection

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 305-0625. The examiner can normally be reached on Monday-Friday from 8:30 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to"

Commissioner of Patents and Trademarks

C/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or:

(703) 308-5397 (for informal or draft communications, please label


"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Calvin Loyd Hewitt II

October 3, 2000

  
James P. Trammell  
Supervisory Patent Examiner  
Technology Center 2700